

REMARKS

Applicants acknowledge receipt of an Advisory Action dated October 26, 2004. In this response Applicants have redrafted claims 28 and 29 in independent form and added claims 30-33. Support for these amendments may be found in the specification, *inter alia*, at lines 5-20 on page 6, at lines 8-13 on page 9 and at lines 6-7 on page 10. Following entry of these amendments, claims 1-13, 15-16 and 18-33 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Telephonic Interview

Applicants wish to thank Examiner Hon for the helpful suggestions she offered during a telephonic interview with Mr. Paul Strain on October 20, 2004. Specifically, Examiner Hon indicated that claims 28 and 29 would likely be allowable if redrafted in independent form. In this response, as noted above, Applicants have redrafted claims 28 and 29 in independent form.

Rejections Under 35 U.S.C. §103

On page 2 of the Office Action dated December 3, 2003, the PTO rejected claims 1-10, 12-13, 15-16, 18-21 and 23-27 under 35 U.S.C. §103(a) as being unpatentable over DE 4438961 to Hammer (hereafter "Hammer '961"). In addition, on page 4 of that Office Action, the PTO rejected claims 11, 22, and 28-29 under 35 U.S.C. §103(a) as being unpatentable over Hammer '961 in view of U.S. Patent 5,679,145 to Anderson *et al.* (hereafter "Anderson"). As set forth below, Applicants respectfully traverse each of these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

Hammer '961

Here, Applicants submit that Hammer '961 fails to teach or fairly suggest an *edible* shaped body as set forth in independent claim 1. Further, Applicants submit that the PTO has failed to establish any proper motivation for modifying Hammer '961 in the manner suggested in the Office Action of December 3, 2003.

As an initial matter, Applicants note that Hammer '961 is the German priority document for U.S. Patent 5,928,737, which was cited in the previous Office Action. As in U.S. Patent 5,928,737, Hammer '961 discloses biodegradable sausage casings which are produced by extrusion, but Hammer '961 fails to disclose edible shaped bodies.

Applicants note that a prior art reference must be considered in its entirety, *i.e.*, as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Here, Applicants submit that a reading of Hammer '961 as a whole would lead one skilled in the art to recognize that Hammer '961 relates to inedible biodegradable sausage casings instead of the presently claimed edible shaped bodies.

In describing the problems with the sausage casings of the prior art, Hammer '961 notes that the casings of the prior art "are not biodegradable and are thus expensive to dispose of". (Last full paragraph on page 2 of the PTO's translation of Hammer '961). Hammer '961 then states that the sausage casings according to his invention should "be biodegradable". (Paragraph bridging pages 2 and 3 of the PTO's translation of Hammer '961).

In addition, each of the 4 Examples in Hammer '961 evaluates the removability of the casing. The evaluation of the removability of the casing from the sausage taken in light of Hammer '961's comments regarding biodegradability and disposal of the used sausage casings would lead one skilled in the art to conclude that Hammer '961 relates to inedible sausage casings.

Words in a patent claim are to be understood as they would be understood by a person skilled in the art of the claimed invention. *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed.

Cir. 1983). Persons of ordinary skill in the sausage casing art understand the term “edible casing” as meaning that the casing is designed and intended to normally be consumed with the sausage filling material, not merely that the casing can be eaten, i.e., without being harmful. With the proper interpretation of the claim language, the present claims clearly differentiate from the cited art.

Applicants also note that the sausage casing according to Example 2 of Hammer ‘961 shows an elongation at break (in the dry state) of about 80 % in longitudinal direction and about 100 % in cross direction. The non-fiber-reinforced casing according to Example 3 of the reference shows an elongation at break which is only slightly less than that. It is commonly known to those skilled in the pertinent art that casings with an elongation at break (in the dry state) in the range of the casings of Hammer ‘961 are no longer chewable and hence cannot be regarded as “edible”, in any event.

The casings of Hammer ‘961 are intended in particular for salami and other long-lasting sausages. This requires a strong casing having a high wall thickness, which, as discussed above, is easily peelable. Edibility is not an issue.

In the last full paragraph on page 5 of the Office Action of December 3, 2003, with regard to the meaning of the term “edible,” the PTO stated that “Applicant is respectfully reminded that animals eat the bark of trees.” Applicants recognize that, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Here, Applicants submit that the PTO has failed to interpret the term “edible” reasonably. As noted above, claim terms must be read as they would be interpreted by those of ordinary skill in the art. Applicants submit that those skilled in the sausage casing art would readily recognize the difference between edible casings and inedible casings (which are peeled away from the sausage and discarded), and Applicants further submit that one skilled in the art would readily recognize that Hammer ‘961 relates to inedible sausage casings (as evidenced, for example, by the discussion of biodegradability of the casing after disposal, the peelability/removability of the casing and the casing wall thickness).

Applicants further submit that, from a reading of Applicants’ specification as a whole, the term “edible” is clearly intended to mean “intended to be eaten by human beings.”

In the Advisory Action dated October 26, 2004, the PTO stated that “the shaped tubular film of Hammer [‘961] is *inherently* edible”. In addition to the points made above, Applicants note that the PTO cannot properly rely on the doctrine of inherency in the context of a §103 rejection, *i.e.*, that which may be inherent is not necessarily known, and obviousness can only be based on what is known. Thus, although, Hammer ‘961 may disclose sausage casings comprising some of the same components disclosed and claimed in the present application, that does not *necessarily* mean that the sausage casings of Hammer ‘961 are edible. In this regard “inherently edible”, in the sense used by the PTO, is clearly not what is intended or meant by the claim language.

For these reasons, Applicants submit that Hammer ‘961 fails to teach or properly suggest edible sausage casings and that the PTO has failed to establish any proper motivation to modify Hammer ‘961 in a manner that would render the sausage casings edible. Accordingly, Applicants submit that the rejection of claims 1-10, 12-13, 15-16, 18-21 and 23-27 under §103 is improper and should be withdrawn.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 2-10, 12-13, 15-16, 18-21 and 23-27, which ultimately depend from independent claim 1, are also non-obvious.

Hammer ‘961 in view of Anderson

With respect to the rejection of claims 11, 22 and 28-29, the PTO has combined Hammer ‘961 with Andersen. The PTO has combined Andersen with Hammer ‘961 because Andersen allegedly “teaches the equivalency of woodpulp fibers with cotton linters in the capacity of fiber reinforcement of starch”.

However, the articles disclosed by Andersen, namely, packaging materials and containers, are non-edible, in the same way that the sausage casings of Hammer ‘961 are not edible. They have a starch-bound foamed cellular matrix reinforced with dispersed fibers. (See abstract). The fibers improve the toughness and the form stability of the article (col. 73, lines 32 and 33). This is just the opposite of what is desired for an edible article. It rather needs to be chewable. Neither Hammer ‘961 nor Andersen provide any motivation to incorporate fibers in an edible article, and the Office Action provides no discussion of a

motivation that would cure this deficiency. Thus, the combination of Hammer '961 with Andersen could not have rendered obvious the presently claimed edible article, and Andersen fails to resolve the basic deficiencies in Hammer '961 which have been outlined above. As a result, neither Hammer '961 nor Andersen, taken either individually or in combination, teach or properly suggest the presently claimed edible shaped body.

Applicants note that PTO's remarks regarding enablement in the paragraph bridging pages 4 and 5 of the Advisory Action dated October 26, 2004. In response, Applicants wish to direct the PTO's attention to the discussion at lines 5-20 on page 6 of the specification. In this passage, Applicants provide specific examples of suitable fibers and discuss the role of these fibers in promotion of digestion.

With particular regard to claims 28 and 29, which have been redrafted in independent form above, Applicants note that the sausage casing according to Example 2 of Hammer '961 shows an elongation at break (in the dry state) of about 80 % in longitudinal direction and about 100 % in cross direction. The non-fiber-reinforced casing according to Example 3 of the reference shows an elongation at break which is only slightly less than that. In contrast, the edible shaped bodies of claims 28 and 29 have an elongation at break (in the dry state) of 12-15 % or less in the longitudinal direction (claim 28) and 20-26% in the cross direction (claim 29). It is commonly known to those skilled in the pertinent art that casings with an elongation at break (in the dry state) in the range of the casings of Hammer '961 are no longer chewable and hence cannot be regarded as "edible". For this reason and in light of Examiner Hon's comments during the above-referenced interview, Applicants believe that claims 28 and 29 are now in *prima facie* allowable form.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of both the rejections under §103.

Newly Added Claims 30-33

In this response, Applicants have added dependent claims 30 and 31 which depend from independent claim 28 and claims 32 and 33 which depend from claim 1. Applicants note that the PTO has not previously considered the combination of features set forth in claims 30 and 31.

With particular regard to claim 30, Applicants note that neither of the cited references, taken either individually or in combination, teach or suggest an edible shaped body “wherein the edible shaped body exhibits a longitudinal elongation at break of 12-15%” and “wherein the edible shaped body exhibits a transverse elongation at break of 20-26%”.

With regard to claim 31, Applicants note that neither of the cited references, taken either individually or in combination, teach or properly suggest an edible shaped body “wherein the edible shaped body exhibits a longitudinal elongation at break of 12-15%,” “wherein the edible shaped body exhibits a transverse elongation at break of 20-26%,” and “wherein the fiber comprises non-digestible dietary fiber.”

With regard to claim 32, Applicants submit that neither of the cited references, taken either individually or in combination, fail to teach or suggest a consumable sausage comprising (i) a meat product and (ii) an edible shaped body according to claim 1 encasing the meat product, wherein the edible shaped body is intended to be consumed with the meat product.


With regard to claim 33, Applicants submit that neither of the cited references, taken either individually or in combination, fail to teach or suggest a method of using an edible shaped body according to claim 1, comprising (a) filling the edible shaped body with a meat product; and (b) consuming the meat product together with the edible shaped body.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

Date 11/30/04
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By 
Richard L. Schwaab
Attorney for Applicants
Registration No. 25,479

Paul D. Strain
Attorney for Applicants
Registration No. 47,369

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.